

Application No.: 09/887,526

15 New Attorney Docket No.: 54484-20001.00

REMARKS

Claims 1-40 are pending and claims 16-28 and 38-40 have been withdrawn from consideration. Claim 1 has been amended to include the feature of "processing the user selection." No new matter has been added.

Claims 1-8 stand rejected under 35 USC 101 as allegedly directed to non-statutory subject matter. In rejecting claims 1-8, the Examiner stated that "claims 1-8 only recite an abstract idea. The recited steps of displaying and creating does not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper and pasting it on a computer." This rejection is respectfully traversed.

The applicable legal authority fails to support the rejection of claim 1, as amended. Specifically, 35 USC 101 states: "Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title." The Supreme Court has stated that Congress intended statutory subject matter to "include anything under the sun that is made by man." (See *Diamond v. Chakrabarty*, 447 U.S. 303, 309 (1980).) While the Supreme Court has noted exceptions to this, it has specifically identified only three categories of unpatentable subject matter. These categories are "laws of nature, natural phenomena, and abstract ideas." (See *Diamond v. Diehr*, 450 U.S. 175, 185 (1981).) Applicants respectfully submit that the steps defined by claims 1-8 are neither laws of nature, nor natural phenomena, nor abstract ideas.

The Federal Circuit has also limited the scope of what it considers to be unpatentable subject matter. In *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 149 F. 3d 1368, 1373 (Fed. Cir. 1998) the court held that a process is patentable if it produces a "useful, concrete, and tangible result." Applicants respectfully submit that the steps defined by claims 1-8 are steps performed by a computer that produce a useful, concrete, and tangible result.

va-84030

Application No.: 09/887,526

16 New Attorney Docket No.: 54484-20001.00

For example, claim 1 includes the step of "processing the user selection." Claim 2 recites "submitting to a remote site" and "creating advertisements." Claim 3 recites "printing a hard-copy." Claims 4 and 5 recite "displaying on a computer, in response to selection by the user." Claim 6 recites "displaying...one advertisement for selection by the user." Claims 7 and 8 describe further features of claims 6 and 1, respectively. With reference to independent claim 1, the last step includes the feature of "creating a preview of the proposed advertisement." Applicants submit that at least the steps of processing the user selection and creating a preview are a useful, concrete and tangible results.

The MPEP states that "when such a rejection [under 35 USC 101] is made, Office personnel must expressly state how the language of the claims has been interpreted to support the rejection." (MPEP, 8th ed. at 2100-7). In making the rejection, the Examiner stated that "all of the recited steps can be performed in the mind of the user or by use of a pencil and paper and pasting it on a computer." Applicants respectfully submit that at least the step of "processing the user selection" cannot be performed solely "in the mind of the user or by use of a pencil and paper and pasting it on a computer." If it is the Examiner's position that this step can be performed solely in the mind of the user or by use of a pencil and paper, Applicants respectfully request that the Examiner more fully explain the Examiner's interpretation of "processing the user selection."

The MPEP further states that "Office personnel have the burden to establish a prima facie case that the claimed invention as a whole is directed to solely an abstract idea or to manipulation of abstract ideas or does not produce a useful result. Only when the claim is devoid of *any* limitation to a practical application in the technological arts should it be rejected under 35 U.S.C. 101." (MPEP, 8th edition, at 2100-7, emphasis added.) As described above, each of claims 1-8 includes at least one limitation of practical application in the technological arts. Therefore, the steps defined by claims 1-8 meet the statutory requirements of 35 USC 101. The rejection of claims 1-8 under 35 USC 101 as being directed to non-statutory subject matter is respectfully traversed.

va-84030

Application No.: 09/887,526

17 New Attorney Docket No.: 54484-20001.00

Claims 1-15 and 29-37 stand rejected under 35 USC 103(a) as allegedly obvious over Matsumoto, U.S. Patent No. 6,763,334. This rejection is respectfully traversed.

In making the rejection, the Examiner stated that "Matsumoto discloses creating a proposed advertisement for a plurality of products for display on a computer. Underwood does not specifically disclose the exact phrases template, formats and specifications." Applicants note that the Examiner has not identified Underwood on the "Notice of References Cited" and Applicants therefore assume that the Examiner intends to refer to Matsumoto. The Examiner further stated that "Official Notice is taken that a template, advertising formats and specifications were common knowledge in the web site design art prior to Applicant's filing date."

Applicants respectfully submit that the this obviousness rejection fails because the Examiner has presented no evidence to support an essential element of the *prima facie* case of obviousness, that the combination of the reference with the common knowledge prior to Applicants' filing date discloses all of the limitations of claim 1. Applicants note that Matsumoto does disclose a "proposed advertisement." However, there is no indication in Matsumoto that the disclosed proposed advertisement is a "preview of the proposed advertisement." Applicants submit that the "proposed" advertisement of Matsumoto is simply a offer for an advertisement and is completely unrelated to a "preview." The Examiner has not even asserted that either Matsumoto or the common knowledge teach "creating a preview of the proposed advertisement" as described in claim 1. For at least this reason, the Examiner has failed to present a *prima facie* case of obviousness.

Claim 1 includes, among other features, the feature of "displaying on the computer, in response to selection by the user, a template that corresponds to a selected one or more of the plurality of advertising formats." Assuming that the Examiner's reference to Underwood was intended to refer to Matsumoto, the Examiner agrees that Matsumoto does not show the template of claim 1. The Examiner's statement that "template, advertising formats and specifications were common knowledge," even if true, is insufficient to support a *prima facie* case of obviousness. The

va-84030

Application No.: 09/887,526

18 New Attorney Docket No.: 54484-20001.00

Examiner has not even asserted that it was common knowledge that "a template that corresponds to a selected one or more of the plurality of advertising formats" is displayed on a computer "in response to selection by the user" as described in claim 1. For at least this additional reason, the obviousness rejection of claim 1 is traversed.

Applicants respectfully submit that they have shown the patentability of at least all independent claims. Accordingly, all dependent claims are themselves patentable insofar as they depend from a patentable independent claim. The Applicants make this assertion without reference to the independent bases of patentability contained within each dependent claim. Accordingly, the Applicants respectfully request the Examiner withdraw the rejections and allow all pending dependent claims.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

va-84030


Application No.: 09/887,526

19 New Attorney Docket No.: 54484-20001.00

In the event the U.S. Patent and Trademark Office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952 referencing Attorney Docket No. 54484-20001.00.**

Dated: November 29, 2004

Respectfully submitted
MORRISON & FOERSTER LLP,

By 
James M. Denaro
Registration No.: 54,063
MORRISON & FOERSTER LLP
1650 Tyson's Blvd, Suite 300
McLean, Virginia 22102
(703) 760-7739

va-84030